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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,230	07/24/2001	Graciela Chichilnisky	23366-705	5882

7590 07/17/2006  
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EXAMINER

GRAHAM, CLEMENT B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/915,230

Applicant(s)

CHICHILNISKY, GRACIELA

Examiner

Clement B. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 14-27, was elected by Applicant's for examining based on election restriction.

**Claim Rejections - 35 USC § 102**

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 14-27, are rejected under 35 U.S.C. 102(b) as being anticipated by

Hawkins et al (Hereinafter Hawkins U.S Patent 5, 497, 317).

As per claim 14-17, Hawkins discloses a system for automating cross border transactions, comprising:

a host system with a distributed relational database accessible and updateable by more than one party to a cross border transaction;

at least one global custodian network coupled to the host system; and at least one sub-custodian coupled to the host system.(see column 3 lines 30-40 and column 7 lines 1-20) and the global custodian network.(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 18, Hawkins discloses wherein all participants in a trade or settlement can track the progress of the trade or settlement with access to the distributed relational database. .(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 19, Hawkins discloses wherein the distributed relational database includes firewalls that separate information specific to subcustodians. .(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 20, Hawkins discloses wherein the distributed relational

database includes details on the execution, audits, trade settlement, and standing instructions for trade processing. .(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 21, Hawkins discloses wherein each participant retains specific information that pertains to knowledge it has at a selected time. .(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 22, Hawkins discloses wherein subcustodians retain information about all global custodians' omnibus accounts that they serve. .(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 23, Hawkins discloses wherein global custodians retain information about all the asset managers' accounts and broker dealers accounts that they serve. .(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 24, Hawkins discloses wherein broker dealers retain information about all the investors' accounts that they serve. .(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 25, Hawkins discloses a method of improving bank to bank instructions between financial institutions, comprising:  
providing a host system with a distributed relational database accessible and updateable by more than one financial institution; and  
transmitting messages between financial institutions for payments, foreign exchange, executions.(see column 3 lines 30-40 and column 7 lines 1-20)  
settlements, or corporate actions providing knowledge of the content and context of the messages as they are sent and received, and identifying their relationship to a single trade or corporate actions event.(note abstract and see column 2 lines 15-50

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and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 26, Hawkins discloses a method for centralizing information required to settle a global cross border transaction, comprising:

providing a host system with a distributed relational database accessible and updateable by more than one party to a cross border transaction.(see column 3 lines 30-40 and column 7 lines 1-20) creating audit trails for cross border transactions utilizing the host system.(note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

As per claim 27, Hawkins discloses wherein the host system provides a secure virtual exchange that enables customized, integrated reporting of trading positions, announcements, instructions, matches, recaps, updates, reconciliation, and billing among other services. (note abstract and see column 2 lines 15-50 and column 3 lines 20-45 and column 5 lines 12-55 and column 7 line 1 and column 8 line 2).

### **Conclusion**

4. The prior art of record and not relied upon is considered pertinent to Applicants disclosure.

Norris (US Patent 5, 940, 811) teaches closed loop financial transaction method and apparatus.

Tooheyl (US 6, 405, 176 Patent) teaches method for processing multiple electronic shopping carts.

Anderson (US 5, 283, 829 Patent) teaches system and method for paying bill electronically.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers


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for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

March 15, 2006

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
Au 3628